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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,040	02/17/2004	Klaus Leyendecker	LIP011DIV	9266

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EXAMINER	
KEASEL, ERIC S	

ART UNIT	PAPER NUMBER
3754	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/780,040	LEYENDECKER ET AL.	
	Examiner	Art Unit	
	Eric Keasel	3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *October 7, 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-6,12 and 13* is/are pending in the application.

4a) Of the above claim(s) *3 and 5* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4,6,12 and 13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 10/156,253.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 7, 2005 has been entered.

Election/Restrictions

2. Applicant's election of Species B in the reply filed on August 30, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 3 and 5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 30, 2004.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 4, 6, 12, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In each of the independent claims, the relationship between the number of control elements (flap devices) to the number of shaft portions to the number of shaft portions appears to introduce new matter into the application. For example, claim 12 recites "a recess" in line 1, "between each two neighboring control elements a shaft portion having first and second ends" in lines 7 and 8, and later recites, "said recess is positioned between said first and second ends of said shaft". As disclosed, there are four control elements with three shafts between each of the neighboring control elements and one recess (15) near each of the shaft portion. However, the claim only recites a single recess and this single recess does not meet the limitation that it is positioned between the first and second ends of the shaft. Furthermore, it is not clear if "a shaft portion" is meant to encompass (what is disclosed as) the three shaft portions between the four disclosed control elements. Claim 13 has a similar ambiguity in that it appears that a plurality of shaft portions is positively recited in line 4, but also recites that each shaft portion is positioned between each two control elements. However, as disclosed, there are four control element and

the shaft portion between the two control elements towards the left (as shown in Fig. 2) is not also positioned between the control elements towards the right. Also, in claim 12, the recitation that the recess is positioned between the first and second ends of the shaft even if the recitation is meant to refer to only a single recess and a single shaft because the figures show the recess (15) as being significantly offset from the shaft and not "between".

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4, 6, 12, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of the independent claims, the relationship between the number of control elements (flap devices) to the number of shaft portions to the number of shaft portions is vague and indefinite. For example, claim 12 recites "a recess" in line 1, "between each two neighboring control elements a shaft portion having first and second ends" in lines 7 and 8, and later recites, "said recess is positioned between said first and second ends of said shaft". As disclosed, there are four control elements with three shafts between each of the neighboring control elements and one recess (15) near each of the shaft portion. However, the claim only recites a single recess and this single recess does not meet the limitation that it is positioned between the first and second ends of the shaft. Furthermore, it is not clear if "a shaft portion" is meant to encompass (what is disclosed as) the three shaft portions between the four disclosed control elements. Claim 13 has a similar ambiguity in that it appears that a plurality of shaft portions is positively recited in line 4, but also recites that each shaft portion is positioned

between each two control elements. However, as disclosed, there are four control element and the shaft portion between the two control elements towards the left (as shown in Fig. 2) is not also positioned between the control elements towards the right. Also, claim 13 has been amended to recite that "said recess is capable of extending beyond the axis of rotation of the flap device". However, the recess is simply a recess and it is unclear how (or if) it is capable of doing anything.

9. In light of the above informalities, the claims have been examined as could best be understood by the examiner. The examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 12 and 13 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Mayer et al. (US Patent Number 5,996,549).

Mayer et al. disclose a flap device for influencing a flow cross-section in a medium-carrying conduit, comprising a control element (20, 22, 24, or 26) arrangeable in the conduit, at least one shaft portion having a first and a second end and of a cranked configuration in a region between the first and second ends (see Fig. 2), means mounting the shaft portion rotatably with respect to the conduit, and means operable to fix the control element in torsionally stiff relationship to the first end of the shaft portion (see column 2, line 57); and also including means

adapted to fix a control element of a further flap device for a further conduit in torsionally stiff relationship to the second end of the shaft portion (see Figs. 1 and 2).

12. Claims 12 and 13 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (US Patent Number 5,005,533).

Depending on how the ambiguity between the number of shafts and the requirement that each shaft must between each two control elements, Suzuki et al. anticipates the independent claims as follows. Suzuki et al. disclose two flap device control elements (12) and a shaft therebetween with a cranked portion between the ends of the shaft. The insert is the combination shown in Fig. 1 and the recess can be read as either the bolt holes or the recess in the housing structure (8). Suzuki et al. disclose the same fixed relation between the control element and the flap but are silent as to the details in the dependent claim.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 4, 12, and 13 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. in view of Hatton (US Patent Number 6,135,418).

Mayer et al. give a broad teaching of what would appear to be a torsionally stiff relationship, but are silent as to the specific press fit connection. Hatton discloses a flap device with multiple control elements connected to a shaft. Hatton discloses numerous methods of connecting the control element to the shaft (see column 5, lines 22-30) including press fitting (see column 5, line 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have assembled the control elements of Mayer et al. to the shaft by press fitting in order to secure the control element to the shaft as taught by Hatton.

15. Claims 6, 12, and 13 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. in view of Pearson et al. (US Patent Number 5,374,032).

Mayer et al. give a broad teaching of what appear to be a torsionally stiff relationship, but are silent as to the specific connection being a flattened portion of the shaft bearing against the control element. Pearson et al. disclose a flap device with a control element bearing against a flattened portion of the shaft (see Fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have assembled the control element of Mayer et al. to the shaft so that a flattened portion of the shaft bears against the control element in order to provide a larger surface to transmit the torque to reduce the possibility of breakage as taught by Pearson et al.

16. Claims 4, 12, and 13 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. in view of Hatton.

Suzuki et al. give a broad teaching of what would appear to be a torsionally stiff relationship, but are silent as to the specific press fit connection. Hatton discloses a flap device with multiple control elements connected to a shaft. Hatton discloses numerous methods of connecting the control element to the shaft (see column 5, lines 22-30) including press fitting (see column 5, line 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have assembled the control elements of Suzuki et al. to the shaft by press fitting in order to secure the control element to the shaft as taught by Hatton.

17. Claims 6, 12, and 13 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. in view of Pearson et al.

Suzuki et al. give a broad teaching of what appear to be a torsionally stiff relationship, but are silent as to the specific connection being a flattened portion of the shaft bearing against the control element. Pearson et al. disclose a flap device with a control element bearing against a flattened portion of the shaft (see Fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have assembled the control element of Suzuki et al. to the shaft so that a flattened portion of the shaft bears against the control element in order to provide a larger surface to transmit the torque to reduce the possibility of breakage as taught by Pearson et al.

Response to Arguments

18. Applicant's arguments filed October 7, 2005 have been fully considered but they are not persuasive.

The examiners disagrees that the amendments to the claims have clear support in the originally filed application and clearly define the metes and bounds of the invention as discussed above. The rejections of the claims with the Mayer reference are maintained because the rejection is still proper given an interpretation of the claims that is both clear and supported by the originally filed application (although some limitations must be read significantly differently).

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (571) 272-4929. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eric Keasel 23 DEC 2005

Eric Keasel
Primary Examiner
Art Unit 3754